REMARKS

Claims 1 – 20 remain in the application and stand rejected. Claims 8, 11 and 14 are objected to and so, are amended herein. The rejection of the claims is respectfully traversed.

Claims 8, 11 and 14 are objected to for containing informalities. Responsive thereto, claims 8, 11 and 14 are amended herein. Reconsideration and withdrawal of the objection to the claims is respectfully requested.

Claims 1, 2, 5, 6, 7, 8, 14, 18 and 19 are rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,088,182 to Taki et al. in view of U.S. Patent No. 5,561,530 to Kanazawa. Claims 3, 4 and 10 are rejected under 35 U.S.C. §103(a) over the combination of Taki et al. and Kanazawa in further view of U.S. Patent No. 6,539,459 to Tadokoro et al. Claim 9 is rejected under 35 U.S.C. §103(a) over the combination of Taki et al. and Kanazawa in further view of U.S. Patent No. 5,579,234 to Wiley et al. Claims 11 – 13 are rejected under 35 U.S.C. §103(a) over the combination of Taki et al., Kanazawa and Wiley et al. in further view of U.S. Patent No. 5,774,725 to Yadav et al. Claims 15 – 17 and 20 are rejected under 35 U.S.C. §103(a) over the combination of Taki et al. and Kanazawa in further view of U.S. Patent No. 6,724,096 to Fisher et al. The rejection is respectfully traversed.

The present invention, as recited in claim 1, is a method of testing storage media in a storage device, wherein a physical storage volume being tested is inserted into an input area, scanned and moved to a drive capable of testing it. Then the storage media is tested and returned to the input area. The physical storage volume is not inserted into the storage subsystem until after it tests good. See, e.g., the specification, page 7, lines 2 – 7. *Also, see*, claims 8, 10 and 11. "Furthermore, the media may be tested even if there is no available permanent rack space to hold the media, because the cartridge being tested is

moved directly from the media input area to the drive, i.e., bypassing the permanent rack space." Page 7, lines 11 – 14.

However, regarding the rejection of claim 1, it appears to be asserted that steps (a) – (c) and (e) are *inherent* in the Taki et al. Figure 7 (a tape library system 29), Figure 8 (the main elements of the tape library system 29 as well as a host computer 41) and Figure 9 (a cross-sectional view of the tape library system 29, taken along a horizontal plane near the cassette storage racks 32) and the corresponding description at col. 9, line 66 – col. 11, line 15. The Office action also makes reference to a thumbnail sketch of the operation of the tape library at col. 1, lines 26 – 33 ("tape cassettes are placed in a rack, and a desired tape cassette is taken, as required, out of the rack by a transfer mechanism and it is loaded on a tape drive unit properly selected from a plurality of tape drive units"). The Office action acknowledges that Taki et al. does not teach "the specific use of a method of testing storage media in a storage device." In fact, the only mention of testing made by Taki et al. is an example provided with reference to using the bar codes (in Figure 15) at col. 16, lines 60 – 63 ("The value of the attribute code may represent for example whether the tape cassette is a special tape cassette used for testing.").

Inherency has no place in a rejection under 35 U.S.C. §103(a). "(T)he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on **'inherency' under 35 U.S.C. 102**, on **'prima facie obviousness' under 35 U.S.C. 103**, jointly or alternatively, ..." *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (emphasis added). Thus, for inherency to apply, all of the alleged inherent elements must be disclosed in a single reference, substantially as claimed. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)" MPEP §2112 (emphasis in original). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or

technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Since the present invention is not rejected under 35 U.S.C. §102, but under 35 U.S.C. §103, Taki et al. is available as a reference, only for what it actually shows. Thus, to apply Taki et al. as a reference for steps (a) – (c) and (e), specifically, it must be shown that Taki et al. teaches "a) inserting a physical storage volume into an **input area** in a storage device; b) scanning an input area on said physical storage volume; c) moving said physical storage volume **to a drive** capable of testing storage media in said physical storage volume; and e) returning tested said physical storage volume to said **input area**." (emphasis added.) As far as the applicants can see, Taki et al. fails to show this.

Furthermore, since Taki et al. does not specifically describe testing storage media, it can only be assumed that Taki et al. tests storage media as described in the background description of the present application, i.e., "inserting the media into the library database, performing the test, and ejecting the media." Page 1, lines 18 – 19. This was a cumbersome and time consuming process. It is apparent that the Taki et al. system uses this cumbersome approach from step S8 of Taki et al. Figure 13, wherein after a tape is identified for the library database by the Taki et al. system, it is stored in a specific shelf position. However, "inserting the media into the library database," and storing it in a specific shelf position is not the same as testing it without inserting it, i.e., "moving said physical storage volume [from an input area] to a drive capable of testing storage media in said physical storage volume" and testing as claim 1 recites. Neither is dismounting and removing it from the shelf to eject the media the same as "returning tested said physical storage volume to said input area." Thus, as far as the applicants can tell, Taki et al. does not move the "physical storage volume to a drive capable of testing storage media in said physical storage volume;" or return the tested "physical storage volume to said input area."

Kanazawa is relied upon to teach what the Office action acknowledges is missing from Taki et al., i.e., "the specific use of a method of testing storage media in a storage device." Thus, it is alleged that "Kanazawa in an analogous art teaches a method of magnetic recording using a magnetic recording medium, such as a magnetic tape, including a step of testing characteristics of the magnetic medium by recording a test signal (col. 1, lines 6-9, Kanazawa)."

Kanagawa teaches a Video Cassette Recorder (VCR) (e.g., col. 1, lines 13 – 14 and col. 6, lines 5 – 6) with an automatic media test function. In particular, the VCR "tests the magnetic tape and records an input signal, after determining that no recorded signal is present on the tape." Col. 7, lines 44 – 45. So, essentially, it is being asserted that it is obvious to combine the Kanagawa method of testing VCR tapes with the Taki et al. tape library system 29 to result in a method of "testing storage media in a storage device" substantially as recited in claim 1. In rejecting a claim under 35 U.S.C. §103(a), it must be shown that the claim taken "**as a whole** would have been obvious... (emphasis added)." As noted hereinabove, it can only be assumed that Taki et al. tests storage media as described in the background description of the present application, i.e., "inserting the media into the library database, performing the test, and ejecting the media." Thus, even if one were to add testing as described for Kanagawa VCR tapes to the Taki et al. tape library system 29, the result would be "inserting the media into the library database, performing the test [the Kanagawa VCR tape testing], and ejecting the media," not the present invention as recited in claim 1. Accordingly, because the combination of Taki et al. and Kanagawa, as far as the applicants can tell, requires "inserting the media into the library database, performing the test, and ejecting the media," rather than testing the media independent of insertion into the library database, the combination of Taki et al. and Kanagawa does not result in the present invention as recited in claim 1.

Regarding claim 8, it is asserted that "Kanazawa teaches that said storage median said physical storage volume tested in step (c) is tested without inserting logical volumes on tested said storage media into a data library (col. 6, lines 19-25, Kanazawa)." As far as the applicants are aware, a VCR does not involve logical volumes. Kanazawa col. 6, lines 19 – 25 describes a test circuit generator, which has nothing to do with inserting logical volumes. Accordingly, the combination of Taki et al. and Kanagawa does not result in the present invention as recited in claim 8.

Claim 14 is amended to indicate that the test storage media is not in the data library. Thus, the combination of Taki et al. and Kanagawa does not result in the present invention as recited in claim 14, as amended.

Furthermore, none of the other references of record adds anything to Taki et al. and Kanagawa to result in the present invention as recited in claims 1, 8 or 14. Because dependent claims include all of the differences with the cited reference as the claims from which they depend, claims 2 – 7, 9, 10, and 15 - 20, which depend from claims 1 and 14, are not made obvious of Taki et al. and Kanagawa alone, or further in combination with any reference of record. Reconsideration and withdrawal of the rejection to claims 1 – 10 and 15 – 20 under 35 U.S.C. §103(a) over the combination of Taki et al. and Kanagawa alone, or further in combination with any reference of record is respectfully requested.

Regarding the rejection of claims 11 – 14 over Taki et al., Kanazawa and Wiley et al. in further view of Yadav et al., claim 11 specifically recites "wherein said tested storage media are tested without being inserted into said data library." As noted hereinabove, Taki et al. must be presumed to insert media into the data library for testing. Neither, does any reference of record teach or suggest that "tested storage media are tested without being inserted into said data library." Accordingly, the combination of Taki et al., Kanazawa, Wiley et al. and Yadav et al. does not result in the present invention as recited in claim 11.

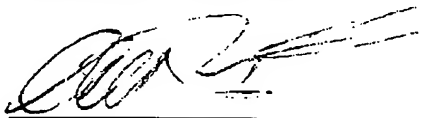
Furthermore, because dependent claims include all of the differences with the cited reference as the claims from which they depend, the combination of Taki et al., Kanazawa, Wiley et al. and Yadav et al. does not result in the present invention as recited in claims 12 – 14, which depend from claim 11. Reconsideration and withdrawal of the rejection to claims 11 – 14 under 35 U.S.C. §103(a) over the combination of Taki et al., Kanazawa, Wiley et al. and Yadav et al. is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance both for the amendment to the claims and for the reasons set forth above, the applicant respectfully requests that the Examiner reconsider and withdraw the objection to the claims, reconsider and withdraw the rejection of claims 1 – 20 under 35 U.S.C. §103(a) and allow the application to issue.

Should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 09-0449 and advise us accordingly.

Respectfully Submitted,



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